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Paper No. 5

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OCT 23 2002

**OFFICE OF PETITIONS**

In re Application of  
Nigel J. Tolson  
Application No. 10/040,534  
Filed: December 28, 2001  
Attorney Docket No.  
111228CX3.US  
Title: FREQUENCY  
SYNTHESIZER FOR DUAL  
MODE RECEIVER

DECISION ON PETITION  
UNDER 37 C.F.R. §1.47(b)

This is in response to the petition under 37 CFR §1.47(b)<sup>1</sup>, filed August 12, 2002.

The petition under 37 C.F.R. §1.47(b) is **DISMISSED**.

Rule 47 applicant is given **TWO MONTHS** from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 C.F.R. §1.47(b)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration

<sup>1</sup> A grantable petition under 37 CFR §1.47(b) requires:

- (1) The petition fee;
- (2) a surcharge if the petition was not filed at the time of filing of the application;
- (3) a statement of the last known address of each of the non-signing inventors;
- (4) proof that a complete copy of the application was sent or given to each of the non-signing inventors for review;
- (5) proof that each of the non-signing inventors refused to sign, or cannot be reached after diligent efforts;
- (6) proof that the Rule 47(b) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (7) proof of irreparable damage, and;
- (8) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 CFR §1.63.

executed by the non-signing inventor. **Failure to respond will result in abandonment of the application.** Any extensions of time will be governed by 37 C.F.R. §1.136(a).

The above-identified application was filed on December 28, 2001, without an executed oath or declaration and identifying Nigel J. Tolson as the sole inventor. On February 6, 2002, applicant was mailed a "Notice to File Missing Parts of Nonprovisional Application - Filing Date Granted", requiring an executed oath or declaration in compliance with 37 CFR §1.63, a surcharge for the late filing of the oath or declaration, and the filing fee. This Notice set a two-month period for reply.

In reply, applicant filed the original petition, along with the associated fee, the fee associated with the late filing of an oath or declaration, and a four-month extension of time to make timely this reply. Petitioner further included a copy of the non-signing inventor's employment agreement, as well as a copy of an e-mail from the non-signing inventor.

Rule 47 applicant has met requirements (1), (2), (3), and (8) above.

Regarding the fourth requirement above, the e-mail fails to list precisely what was sent to the non-signing inventor, and merely mentions "docs". As such, it fails to establish that a complete copy of the application papers were sent to the non-signing inventor. Where a refusal of the inventor to sign the application papers is alleged, the Office requires the petitioner to establish that a bona fide attempt was made to mail a complete copy of the application, which entails the specification, claims, drawings, and oath or declaration.<sup>2</sup> On renewed petition, it should be established that a complete copy of the application was sent to the non-signing inventor at his last known address.

Regarding the fifth requirement above, it follows that since it has not been shown that a complete copy of the application was sent to the inventor, one cannot refuse to sign something which one has not seen. A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed<sup>3</sup>.

Regarding requirement (6), Rule 47(b) applicant has failed to prove sufficient proprietary interest in the subject matter to justify the filing of the application<sup>4</sup>. The declaration sets forth that the non-signing inventor used to be employed by the purported assignee. Petitioner has also included a copy of the employment agreement. Unfortunately, no assignment documents have been provided, and no Reel and Frame number where the recordation of this assignment may be found has been provided. Furthermore, there is no record in the PTO's Patent Application Location and Monitoring System of an Assignment involving this application. Furthermore, no

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<sup>2</sup> See MPEP 409.03(d).

<sup>3</sup> *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

<sup>4</sup> See MPEP §409.03(f).

the "Inventions" section of the employment agreement (found on page 8) explicitly states that the employee is obligated to assign only those inventions which relate "either directly or indirectly to the business of the employer" (paragraph 17.1), and no statement has been made to establish that the present invention falls within these parameters. These facts fail to establish that the petitioner has any proprietary interest in the application at hand.

Regarding the seventh requirement above, no proof of irreparable damage has been submitted<sup>5</sup>. A statement by Rule 47(b) applicant that the filing is necessary to preserve the rights of the parties would be sufficient.


In light of the recent events, the USPTO **strongly** prefers that the reply to this letter be submitted by facsimile<sup>6</sup>. However, if applicant cannot submit the reply to this letter by facsimile (or hand-delivery<sup>7</sup>), the reply may be mailed<sup>8</sup>.

**Notice regarding fees:**

Historically the fees that the USPTO charges for doing business increase at the beginning of each fiscal year (October 1). However, no final determination has been made on fees for FY03 at this point, and fiscal year 2003 was started with the same fee structure as last fiscal year. Please be advised that applicants should monitor the USPTO website for future updates whenever any necessary money is sent. For more information, see [www.USPTO.gov](http://www.USPTO.gov), click on "News and Notices", and under the "Patents" column you will find the above information<sup>9</sup>.

**The application file will be retained in the Office of Petitions for two (2) months.**

Telephone inquiries regarding this decision should be directed to Petitions Attorney Paul Shanoski at (703) 305-0011.

  
Beverly M. Flanagan  
Supervisory Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Patent Examination Policy

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<sup>5</sup> See MPEP §409.03(g).

<sup>6</sup> (703) 308-6916, Attn: Office of Petitions.

<sup>7</sup> Office of Petitions, 2201 South Clark Place, Crystal Plaza 4, Suite 3C23, Arlington, VA 22202.

<sup>8</sup> Commissioner for Patents, Box DAC, Washington, DC 20231.

<sup>9</sup> The direct URL is: <http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/feenotice.htm>